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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,842	11/14/2000	Martin Cipar		6149

6449 7590 11/19/2002

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WASHINGTON, DC 20005

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 11/19/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/710,842

Applicant(s)

Martin Cipar

Examiner

Anne Marie Grunberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 22, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-18 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

It is understood that claims 1, 7, and 10 will be amended to include the ATCC Accession number once a deposit has been made. Additionally, it is understood that Applicant will amend the specification to include the date of deposit.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections*

1. Claims 1 and 10 and dependent claims 2-9 and 11-18 are newly rejected under 35 U.S.C. 112, second paragraph, for the reasons stated below.

Claim 1 is drawn to a "sample of regenerable cells" which were deposited. However, on page 5 of the "Remarks" of Paper #5, it states that "tuber tissue" is deposited. During a telephone call to the attorney, the Examiner was under the impression that vials of microtubers were to be deposited with the ATCC. If microtubers are indeed going to be deposited, then Applicant needs to amend the information in the specification concerning deposit, as well as

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clarify in the averment that microtubers are being deposited. Additionally, the claim needs to be changed so that -- a sample of microtubers have been deposited -- as opposed to "regenerable cells" which implies tissue culture.

2. Claim 10 recites the limitation "said plant" in line 2. It is not clear if the regenerated plant or the plant of claim 9 is referred to. If the plant of claim 9 is referred to then the claim further does not make sense because no other plant than 'FL1879' can have the same physiological and morphological characteristics of 'FL1879'.

### *Written Description*

Claims 8, 9, 11, 12, 13, and 14-18 and dependent claim 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims that recite a seed wherein the resulting plant is not specified and adequately described in the specification are rejected because the inventor was not in possession of the claimed invention at the time of filing. As such, all possible crosses of the instant plant are claimed, however all possible crosses using the parent plant have not been adequately described in the specification. The specification only discloses the plants grown from the deposited tubers.

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In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of a plant, or even a cell, could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotype of the claimed plant has been described.) In this case, the few disclosed embodiments are not representative of the enormous number of products claimed. The claims encompass every potato plant grown from seeds of the deposited tubers. Plants have many phenotype traits, which vary independently, so millions of possible phenotypes are possible and claimed. The specification discloses only the potato plant 'FL1879' and the deposited tubers but not the heterozygous population claimed. Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is not possible to adequately describe the claimed products because the cross of hybrid plant gives rise to a heterozygous population. One skilled in the art would not have been able to predict all of the resulting phenotypes. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of the huge genera recited in the claims at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genera.

This rejection could be overcome by limiting the claims to the deposited tubers, plants grown therefrom and their asexually propagated progeny.

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3. Claims 10, 11, and 15, and dependent claims 12, 13, 14, 16, and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims limited to potato tuber FL1879 and plants grown from the tuber or asexually propagated from the tuber, as well as a method of producing an F1 hybrid seed by crossing the plant with another does not reasonably provide enablement for claims broadly drawn to a potato plant regenerated from a tissue culture of a plant other than 'FL1879' having the same characteristics as 'FL1879' nor does it reasonably provide enablement for claims drawn to a method for producing any generation of potato seed or for producing a hybrid potato seed using anything other than 'FL1879'. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The specification only provides guidance for a potato plant regenerated from the tissue culture of the 'FL1879' or the asexual progeny of 'FL1879' and having all the characteristics of 'FL1879'. The specification also only provides guidance for a method of producing an F1 hybrid potato seed and harvesting the resultant F1 hybrid seeds wherein the first or second potato plant is 'FL1879'. No guidance is provided regarding any plant other than 'FL1879' or any other method of producing anything other than an F1 hybrid potato seed. In contrast, claim 10 is drawn to a potato plant regenerated from any potato tissue culture other than 'FL1879' yet still have all the physiological and morphological characteristics of 'FL1879'. Claim 11 is drawn to a method of producing any generation hybrid and thus harvesting any generation hybrid potato

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seed. Claim 15, in addition to the problems of claim 11 is also drawn to a method wherein any possible future offspring of 'FL1879' is used to produce hybrid seed.

Given the claim breadth, unpredictability as defined in MPEP 2164.03 and lack of guidance as discussed above, undue experimentation would have been required by one skilled in the art to produce a potato plant regenerated from a plant other than 'FL1879' that had the same physiological and morphological characteristics. Additionally, undue experimentation would have been required by one skilled in the art to produce any generation of hybrid potato and harvesting any generation of seed. It also would have been undue experimentation to use any possible offspring of 'FL1879' to produce hybrid seed.

This rejection may be obviated by limiting claim 10 to a plant regenerated from tissue culture 'FL1879' such that the regenerated plant has all the physiological and morphological characteristics of 'FL1879'. Claim 11 should be changed by inserting --an F1 hybrid-- in line 1 instead of "a hybrid". At line 2, --F1-- should be inserted before "hybrid" so that it reads, "... the resultant F1 hybrid potato seed....". Claim 15 should be amended as in claim 11 and in line 4, "of claim 9" should be deleted and replaced with --'FL1879'--.

4. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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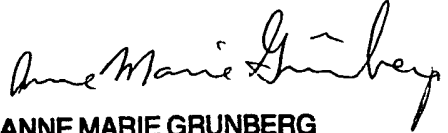
Claims 1-18, are deemed free of the prior art, given the failure of the prior art to teach or suggest a potato plant having all of the physiological and morphological characteristics and exact genotype as the exemplified variety.

No claim is allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The examiner can normally be reached Monday through Friday from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax phone number for this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
ANNE MARIE GRUNBERG  
PATENT EXAMINER